



#13 / Appeal Brief
L. H. Morgan
7/29/03
PATENT

Docket No. 430672000101

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E. Thomas Wheelock

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

RECEIVED

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In the application of:

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MORAN

Serial No.: 09/708,766

Filing Date: November 7, 2000

For: ERGONOMIC BOOKPACK

Technology Center: 3700 TECHNOLOGY CENTER R3700

Art Unit: 3727

APPEAL BRIEF

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P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Brief is in an appeal from the final rejection of claims 1-26, all of the claims in the application, dated June 26, 2002. A Notice of Appeal was filed December 20, 2002.

The requisite fee under 37 CFR 1.17(c) accompanies this Brief. This Brief (with two attachments) is filed in triplicate.

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REAL PARTY IN INTEREST

The real party in interest in this application is Zero g Technologies, LLC, a California limited liability company.

RELATED APPEALS AND INTERFERENCES

There are currently no other appeals or interferences that would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

STATUS OF CLAIMS

A true copy of the claims on appeal in this application is included in the Appendix as Attachment 1. Claims 1-26 have been rejected in the final Office Action. No claim has been allowed. Claims 21-26 were added subsequent to filing.

STATUS OF AMENDMENTS

An Amendment under 37 CFR 1.116 was filed on December 20, 2002 (Paper No. 10) but was not entered per an Advisory Action dated March 7, 2003 (Paper No. 11) as raising "new issues that would require further consideration," more specifically that "the amended claims require further search and consideration since the dependency of claims 2-7 are now from newly independent claims."

INVENTION SUMMARY

This patent application may be best explained as directed to a backpack that is supported from the wearer's shoulders by straps that are attached to the backpack body in such a way that the center of gravity of the backpack is shifted inwardly and closer to a wearer's back. Pressure from the weight of the pack is more evenly distributed on that wearer's back and shoulders.

Figure 9 in the application shows the conceptual advantages of the pack. The backpack body 200 includes, in the depicted variation, shoulder straps 300 that are attached to the body of the pack in such a way that top straps or members 600, working alone or in conjunction with top support members 640, act through the points of attachment to the backpack to “redirect the forces acting along the shoulder straps 300 along the top straps 600, again reducing the load placed on the wearer’s shoulders.” See page 25 of the application.

Again, in concept, the invention described in the application includes a number of backpack structures that improve the comfort of the backpack by shifting the center of gravity towards the back of the wearer.

There are a number of different ways in which this desired function is accomplished. The variation found in independent claims 1, 8, and 15 require that the shoulder support strapping be attached to the backpack body at a junction between a “top region” and an “outer region”. The explanation of what a “region” is with respect to the described backpack may be found beginning at about page 4 as that material explain Figure 2. That material explains that a backpack body may have a “topside or region 202” and “an outer side or region 208” and where those regions are located. These terms have been used consistently throughout the prosecution of this application, but have not apparently been applied in the Office Action

ISSUES

The issues on appeal correspond directly to the rejections recited in the final Office Action:

1.) Whether claims 1-26 are properly rejected under 35 USC 112, paragraph 2, as failing to set forth the subject matter regarded as applicant’s invention. Specifically, whether each of the claims fails to correspond in scope to “that which applicants regard as the invention.” Additionally, whether claims 25 and 26 are indefinite as being “incomplete for omitting essential structural cooperative relationships.”

2.) Whether claims 1, 3, 4, 5, and 15 are anticipated by U.S. Patent No. 6,130,616, to Sizemore.

3.) Whether claims 1, 7-9, 11-13, 15, 16, and 21 are anticipated by U.S. Patent No. 6,024,265, to Clements.

4.) Whether claims 6, 14, and 17 are properly rejected under 35 USC 103(a) as unpatentable over Clements (above) in view of U.S. Patent No. 6,179,187, to Lemire et al.

5.) Whether claims 2, 10, and 18-26 are appropriately rejected under the judicially created doctrine of obviousness type double patenting as unpatentable over claims 1, 16, and 19 of U.S. Patent No. 6,164,509, the parent patent to this application.

GROUPING OF CLAIMS

For the purposes of this appeal only, the claims on appeal rise or fall together.

ARGUMENTS

1.) USC § 112, second paragraph

Claims 1-26 stand finally rejected under 35 USC 112, second paragraph, as failing to set forth the subject matter which appellants regard as their invention. In support of the rejection the Office Action states:

“Evidence that claims 1, 8, and 15 fail to correspond in scope with that which applicants regard as the invention can be found in U.S. Patent No. 6,164,509 filed July 19, 1999. In that application, applicants have stated that *at least one side support member disposed adjacent one of the lateral sides and having a proximate end connected to the backpack body at a second juncture between the outer side and one of the lateral sides and a distal end connected to one of the shoulder support members*, which was a reason for allowance over the prior art. This statement indicates that the invention is different from what is defined in the claims because there is no support for the breadth of the claims as presented in the original application.

“Claims 25 and 26 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“Claim 25 is rejected to under 35 USC 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the distal ends of the two shoulder support members connected to each other.

“The dependent claims not specifically mentioned are rejected as being dependent upon a rejected base claim, since they inherently contain the same deficiencies therein.”

Appellants disagree.

It is appropriate under the statute¹ to reject a claim as not drawn to an applicant's invention where there exists evidence in an amount of necessary to overcome both the statutory presumption that what is claimed in a patent application is, in fact, the invention an applicant wishes to claim and the observations by the United States Court of Appeals for the Federal Circuit that: “without evidence to the contrary, an Examiner generally should presume that a claim recited what the applicant regards as his invention.” See *Litton Systems, Inc. v. Honeywell, Inc.*, 140 F.3d 1499, 46 USPQ2d 1321 (Fed. Cir. 1998), *petition for reh'g denied and suggestion for same reh'g in Banc declined*, 145 F.3d 1472, 47 USPQ2D 1106 (Fed. Cir. 1998) and *In Re Moore*, 439 F.2d 1232, 1325, 169 USPQ 236, 238 (CCPA 1971). The final rejection here urges that the Examiner's Amendment and the included Reason for Allowance over the prior art, the Reasons being found in the parent patent, is in fact evidence that the Appellants-Applicants intended to claim an invention different than that found in the claims on appeal.

A simple reading of the words in that Examiner's Amendment as quoted above from the final rejection say only that certain limitations in the claims are not found in the prior art. There are no “mandatory” words there, such as the “invention must include...” or words of exclusion “my invention does not include...” There has been no explanation in the prosecution in this application how the apparently simple explanation of why those claims were allowed, by the

¹ 35 USC 112, paragraph 2 indicates that:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”

examiner in the parent application/patent, transmogrified into a rigid definition-of-invention that could not be varied.

Appellants note that the reasons for allowance cited there are accurate but cannot be seen as the source of an admission by Appellants that the “invention” (as that word is used in the statute) is somehow different from that found in the claims. The citation in the Examiner’s Amendment in the parent application is believed to be accurate as it relates to the claims finally allowed. It is not relevant to the claims on appeal that recite a different variation of the conceptual invention nor is that quote seen as an admission that relates to anything other than the finally allowed claims there.

The MPEP (Section 2172) even indicates in the section labeled “III. SHIFT IN CLAIMS PERMITTED” that the second paragraph of USC 112 does not “prohibit applicants from changing what they regard as their invention during the pendency of the application” citing *In Re Sanders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971). The MPEP further notes in explaining that case, that:

“The fact that claims in a continuation application were directed to originally disclosed subject matter which applicants had not regarded as part of their invention when the parent application was filed was held not to prevent the continuation application from receiving benefits of the filing date of the parent application under 35 USC 120. Citing *In Re Brower*, 433 F.2d 813, 167 USPQ 684 (CCPA 1970).”

Even if Appellants are considered to have shifted their invention for reasons of whimsy, the Appellants are entitled to do so if they pay the fees. They have paid the fees.

The final rejection under 35 USC 112, paragraph two, is in error and should be reversed.

There have been instances under which the Federal Circuit, in interpreting 35 USC 112, paragraph one, has found that a patent applicant has claimed material that had not been “described” in the manner required by that statute. Typical of the cases under 35 USC 112, paragraph one, showing failure to adhere to the written description requirement is *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998). However, the

rejection on appeal relies not on a demonstration in the final rejection that the claims failed to adhere to the description requirement, but instead were said only to not agree in scope with what the “applicant considered to be his invention.”

Reversal of this rejection is requested.

Claims 25 and 26

The claims 25 and 26 stand finally rejected as “indefinite” or “incomplete for omitting...relationships of elements...[specifically]...The distal ends of the two shoulder support members connected to each other.”

Appellants disagree. Appellants note that they have not anywhere specified that it is somehow necessary or essential that the “distal ends” of the “shoulder support members” necessarily be connected to each other as a feature of the invention. Such is a variation, of course. That those two ends are connected to each other is in fact required by claim 25. Since the specific “omission” is not in fact an omission -- the words are found in claim 25 -- it is not clear why, even in the view noted in the final Office Action, why the claims are considered to be unclear.

Additionally, claim 25 is indicated to be “incomplete for omitting essential cooperative relationships of elements, such omission amounting of a gap between the necessary structural connection.” Again, the allegedly omitted “structural cooperative relationships” were said to be that “the distal ends of the two shoulder support members connected to each other.” Since these words are found in claim 25, Appellants are at a loss as to how to respond to the rejection, variously by argument or amendment or in some other manner, to rectify the question raised in the final rejection.

A reversal of this rejection is requested.

2.) Rejections under 35 USC § 102 - Sizemore

Claims 1, 3, 4, 5, and 15 stand finally rejected under 35 USC 102(e) as anticipated by Sizemore (U.S. Patent No. 6,130,616). In support of the rejection the Office Action states:

Sizemore discloses an ergonomic backpack comprising:

- “A backpack body (1);
- “A plurality of shoulder support members (2), each having a proximal and connected to the body at first transition region (Figure 3);
- “The body comprises a single, seamless, continuous member to the degree applicant claims:
- “The backpack is comprised of nylon with a fineness between 500 denier and 1050 denier (Column 5, lines 27-28); and
- “A plurality of straps (Figures 1-3).”

Appellants disagree.

Each of the appealed independent claims requires that “each shoulder support member proximal end [be] connected to the backpack body at a first transition region between the top region of the backpack body and an outer region of the backpack body.”

The final rejection merely notes that the Sizemore backpack has a “proximal and [sic - “end”] connected to the body at a first transition region (Figure 3)...” Figure 3 appears to show a backpack of some kind -- also shown in Figures 1 and 2 -- upon which the shoulder straps are attached to a junction at the top of the backpack body near the wearer’s body. As Appellants noted above, the meaning of upper and outer and side regions is discussed in the specification. The final Office Action fails to recite the factual basis, the pictures or words, in the Sizemore patent upon which the claim elements specified by the terms “outer region” and “side region” are supposedly anticipated. The final Office Action simply does not mention these terms nor does it lead to one reading that Office Action to where in the patent such a specific connecting region may be found. The reason is also a simple one: connecting the shoulder straps to the backpack body at a region between the “outer region” and “side region” is not disclosed.

Moreover, in assessing the remainder of the Sizemore patent, there is no indication that the backpack disclosed in Sizemore has a variation in which the shoulder members are attached in any other fashion to the backpack body.

In sum, the Sizemore patent simply does not show all of the elements found in appealed claims 1, 3, 4, 5, and 15 and does not therefore anticipate them.

A reversal of this rejection is respectfully requested.

3.) 35 USC § 102 - Clements

Claims 1, 7-9, 11-13, 15, 16, and 21 stand finally rejected under 35 USC 102(e) as being anticipated by Clements (U.S. Pat. No. 6,024,265). In support of the rejection the Examiner states:

“Clements discloses an ergonomic backpack comprising:

- A backpack body (1);
- A plurality of shoulder support member (11), each having a proximal end connected to the body at first transition region (Figure 4);
- An adjustable hip belt (12) attached to the backpack body, wherein the hip belt is comprised of two pieces, each respectively attached to a lateral side (Figures 4 and 5);
- The body comprising a single, seamless, continuous member to the degree applicant claims;
- The backpack is comprised of nylon;
- A plurality of straps (Figure 1);
- The hip belt is attached to the backpack body at one or more of the straps (Figure 1); and
- “The distal end of each shoulder support member is connected to the backpack body at a second transition region between the outer region of the backpack and a lateral side region of the backpack (Figure 6), to the same degree appellant claims.”

Appellants disagree.

As a matter of simplicity, in this argument, Appellants note that the final Office Action indicates that the patent shows “a plurality of shoulder support members (11), each having a proximal end connected to the body at a first transition region (Figure 4)”. Again, the final

Office Action fails to show where in the Clements patent may be found, the elements “first transition region” between a “top region of the backpack body” and “an outer region of the backpack body.” The number of words in claim 1 specifying these elements constitute about one-third of the words there.

Furthermore, it is noted that Clements’ Figure 4 shows what appears to be shoulder straps being attached or connected to the backpack body at an area of the backpack closest to the wearer’s body. That attachment point, by Appellants’ attorney’s estimate, to be between the wearer’s shoulder blades when the backpack is worn. That attachment or connection site does not appear in any way to be at a site near a top or outer portion of the Clements’ backpack body. Additionally, there is no discussion of another variation in the Clements patent indicating that such a variation would be desirable.

Since the final rejection over Clements is inappropriate for not specifying where each of the claimed elements may be found in the cited patent and, indeed, the shoulder straps appear factually to be connected to the backpack body in some other fashion, reversal of the rejection is completely appropriate.

4.) 35 USC § 103 - Clements v. Lemire et al.

Claims 6, 14, and 17 finally stand rejected under 35 USC 103(a) as being unpatentable over Clements in view of Lemire et al. In support of the rejection the Office Action states:

“Clements discloses all of the limitations of claims 6, 14, and 17 except the backpack body comprising a yoke disposed along the top region and connected to each shoulder support member. However, Lemire teaches a backpack having a yoke (9) disposed along the top region and connected to each shoulder support member. It would have been obvious to attach the yoke of Lemire to the backpack of Clements. Doing so would provide an alternate means of attaching the shoulder support members to the backpack and allow more comfort to the wearer.”

Appellants disagree.

The Lemire et al. patent fails to provide the material otherwise not found in the Clements et al. patent. The Lemire et al. patent does show a yoke but does not provide disclosure of a structure in which a shoulder support member has a proximal end connected to a backpack body between a top section of that body and an outer section of that body. Again, insofar as understood what is disclosed by the two patents, the ends of the shoulder straps are attached to the side of the backpack nearest body. Such connection or attachment site is not what is required by the claims.

Reversal of the rejection is therefore requested.

5.) Double Patenting Rejection

Claims 2, 10, and 18-26 stand finally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1, 16 and 19 of U.S. Patent No. 6,164,509 (copy included as Attachment 2). In support of the rejection, the Office Action notes:

“Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the same subject matter that made the claims allowable over the prior art.”

Appellants disagree.

Appellants believe that the test cited in the final Office Action -- “they [the respective two sets of claims] are not patentably distinct from each other because they claim the same subject matter that made the claims allowable over the prior art” -- is legally erroneous. If that is the standard applied in the final Office Action, Appellants urge reversal on that basis alone. Comparing the two sets of claims to the prior art is not the test.

So far as is determined from the case law, a rejection under judicial double-patenting involves only a comparison of the claims in the application to those in the patent. As MPEP 804 notes, the rejection is “based on a judicially created doctrine grounded in public policy in which is primarily intended to prevent prolongation of the patent term by prohibiting claims in the

second patent not patentably distinguishing from claims in the first patent.” MPEP section 804 further goes on to note that:

“... any obviousness-type double patenting rejection should make clear:

“(A) the differences between the inventions defined by the conflicting claims--a claim in the patent compared to a claim in the application;

(B) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.”

There has been no such analysis in the two Office Actions provided. Furthermore, it is not apparent from a reading of the two sets of claims -- and the contents of those claims -- how the conclusion provided in the final Office Action was made. Indeed, claim 1 of the parent ‘509 patent requires that the shoulder support member proximal end be connected to the backpack body at a juncture “between the top side and the body side.” The claims here, it will be remembered, require that the support member be connected between a “top region” and an “outer region.” Consequently, in a factual sense, the Appellants have not been provided with any analysis of why a connection of the shoulder straps to one section of the backpack body would render those straps’ connection to another portion of the backpack body to be obvious in the sense required by a judicial obviousness-type double-patenting rejection

In summary, the test applied in the final Office Action is not supported in the case law. The Office Action has not provided, under a proper test of judicial double patenting, any reason why the differing limitations found in the claims of this appealed application would be obvious from the apparently disparate connection regions recited in the claims of the parent case.

Reversal of this rejection is requested.

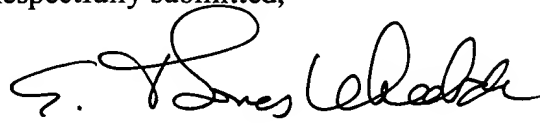
SUMMARY

The various rejections provided in the final Office Action are without either legal basis (in the case of the rejections under 35 USC 112, paragraph two, and under judicial double patenting) or are without factual support. Reversal of the final rejection is completely appropriate and is requested

Respectfully submitted,

Dated: July 21, 2003

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Attachments

Attachment A - set of claims on appeal

Attachment B - parent patent number 6,164,509

ATTACHMENT 1

CLAIMS ON APPEAL

1. An ergonomic backpack comprising:
a backpack body, and
a plurality of shoulder support members, each shoulder support member having a distal end and a proximal end, each shoulder support member proximal end connected to the backpack body at a first transition region between a top region of the backpack body and an outer region of the backpack body.
2. The backpack of claim 1 additionally comprising at least one side support member disposed adjacent a lateral side region of the backpack body and having a proximal end connected to the backpack body at a second transition region between the outer region and the lateral side region and a distal end connected to one of the shoulder support members.
3. The backpack of claim 1 wherein the backpack body comprises a single, seamless, continuous member.
4. The backpack of claim 1 wherein the backpack body comprises Nylon.
5. The backpack of claim 1 wherein the backpack body comprises a fineness of between about 500 denier and about 1050 denier.

6. The backpack of claim 1 additionally comprising a yoke disposed along the backpack body top region and connected to each shoulder support member.

7. The backpack of claim 1 wherein a bottom region of the backpack body has a stiffness higher than a stiffness of the rest of the backpack body.

8. An ergonomic backpack comprising:

a backpack body,

a plurality of shoulder support members, each shoulder support member having a distal end and a proximal end, each shoulder support member proximal end connected to the backpack body at a first transition region between a top region of the backpack body and an outer region of the backpack body, and

a hip belt attached to the backpack body.

9. The backpack of claim 8 wherein the hip belt comprises a first hip belt piece and a second hip belt piece, each of said first and second hip belt pieces having a distal end and a proximal end,

wherein the first hip belt piece proximal end is attached to a first lateral side region of the backpack body, the second hip belt piece proximal end is attached to a second lateral side region of the backpack body, and each of the first and second hip belt piece distal ends is configured to be releasably connectable to each other.

10. The backpack of claim 8 additionally comprising two side support members, each disposed adjacent the first and second lateral side regions, respectively, and wherein each side support member has a proximal end connected to the backpack body at a second transition region between the outer region and the lateral side region and a distal end connected to one of the shoulder support members.

11. The backpack of claim 8 wherein the hip belt is adjustable.

12. The backpack of claim 8 wherein the backpack body comprises a single, seamless, continuous member.

13. The backpack of claim 8 wherein the backpack body comprises Nylon.

14. The backpack of claim 8 additionally comprising a yoke disposed along the backpack body top region and connected to each shoulder support member.

15. An ergonomic backpack comprising:
a backpack body comprising a plurality of straps, and
a plurality of shoulder support members, each shoulder support member having a distal end and a proximal end, the shoulder support member proximal end connected to the backpack body at a first transition region between a top region of the backpack body and an outer region of the backpack body.

16. The backpack of claim 15 additionally comprising a hip belt attached to the backpack body at one or more of said straps.

17. The backpack of claim 15 additionally comprising a yoke disposed on the backpack body along one of said straps.

18. The backpack of claim 15 additionally comprising two side support members, each disposed adjacent the first and second lateral side regions, respectively, and wherein each side support member has a proximal end connected to the backpack body at a second transition region between the outer region and the lateral side region and a distal end connected to one of the shoulder support members.

19. The backpack of claim 15 wherein the plurality of straps comprises four or more straps, and wherein the first two of said straps are parallel to one another and wherein the other two of said straps are (a) parallel to one another and (b) perpendicular to the first two of said straps.

20. The backpack of claim 19 wherein each of said first two straps and second two straps are spaced apart from each other to define an aperture through which the interior of the backpack body is accessible.

21. The backpack of claim 1 wherein the distal end of each shoulder support member is connected to the backpack body at a second transition region between the outer region of the backpack and a lateral side region of the backpack body.

22. The backpack of claim 21 additionally comprising a member adapted to guide the shoulder support member along a lateral side region of the backpack body.

23. The backpack of claim 21 additionally comprising a ring attached to the lateral side region and having one of said shoulder support members threaded through said ring.

24. The backpack in claim 1 wherein the distal end of each shoulder support member is connected to the backpack body at a third transition region between the outer region of the backpack body and the bottom region of the back pack body.

25. The backpack in claim 1 having only two shoulder support members, with the distal ends of the two shoulder support members connected to each other and provides support to the lower outer region of the backpack body.

26. The backpack in claim 25 additionally comprising a plurality of rings connected to the body of the backpack and having one of said shoulder support members threaded through each ring.